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REMARKS

The present amendment replies to the Non-Final Office Action dated October 7, 2005. Claims 1-23 are currently pending in the application. New claims 21-23 have been added. No new matter has been added with the amendment.

In the non-final office action, Examiner Deane rejected claims 1-20 on various grounds. The Applicants respond to each ground for rejection as subsequently recited herein and respectfully request reconsideration and further examination of the present application under 37 CFR § 1.112.

A.   **Claims 1-3, 5-11 and 13-20 were rejected under 35 U.S.C § 102(e) as being anticipated by U.S. Patent Application No. US 2004/0193343 to Tan et al.**

The Applicants have thoroughly considered Examiner Deane's remarks considering the patentability of claims 1-3, 5-11, and 13-20 over U.S. Patent Application No. 2004/0193343 to Tan et al. (Tan). The Applicants have also thoroughly read the Tan Application. The Examiner's rejection is respectfully traversed.

In order for this §102(e) rejection to stand, each and every element of the claimed invention must be disclosed in at least as great detail as claimed. Tan fails to disclose each and every element, and therefore this rejection must fall.

Tan does not disclose "setting a unit request call trigger at the telematics unit from a call center" as claimed in claims 1, 9, and 17. Instead, Tan discloses at ¶ 20 "a user activates a telematics mode on the vehicle, thereby initiating a wireless connection from the vehicle to the server..." Additionally, Tan discloses examples of how a user initiates a wireless connection including "by pressing mode control button 118 of audio system 110, by making an appropriate voice command...by activating a button on a hands-free phone electrically coupled to the telematics unit." In contrast, a unit request call trigger is a condition detected to activate a function based on an event occurrence.

The Examiner alleges if the service provider has not activated the MIN, the user will know to trigger the device again. Even if the Examiner's allegation is correct, which Applicants do not concede, what claims 1, 9, and 17 actually require is "configuring the telematics unit in response to the received unit request call." Additionally, claim 22 requires "the unit request call is received at the call center responsive to the unit request call trigger at the telematics unit." New claim 22 finds support in the specification, *inter alia*, at page 10, lines 21-23. Additionally, claim 23 requires "an *automated* inbound configuration call whereby the telematics unit and a subscriber cell phone is configured based on an available enrollment data and a MIN (emphasis added)." New claim 23 finds support in the specification, *inter alia*, starting at page 10, line 9.

Therefore, Tan does not disclose each and every element of claims 1, 9, and 17. and the §102(e) rejection must fall.

Additionally, Tan does not disclose "determining at the call center an available enrollment data" and "configuring the unit request call trigger based on the determination" as claimed in claims 2, 10, and 18. Enrollment data is defined in the specification at page 7, lines 26-28, as "a customer data record or a personal calling number." At most, Tan discloses that data content is provided by "a traffic service provider, a hotel registration service provider, a weather report service provider" (see, ¶24, Tan). Additionally, Tan does not disclose determining available enrollment data at the call center. Similarly, Tan does not disclose configuring the unit request call trigger based on the determination. Therefore, the Examiner's rejection of claims 2, 8, and 10 is respectfully traversed.

The Examiner erroneously alleges that the preset ID as disclosed in Tan reads on the claimed MIN. At most, Tan discloses (¶8) that the preset ID is an identification for a selected preset button, and therefore the preset ID of Tan cannot "read on" a MIN. Furthermore, Tan does not disclose "determining if a personal calling number is available" as claimed in claim 6.

Tan discloses a preset ID that "the telematics unit…retrieves a store preset ID from memory 126 corresponding to the particular preset button 112 selected." Tan also discloses in ¶ 8 "a *plurality* of preset buttons, the preset buttons configured to select a stored preset identification" (emphasis added). Finally, Tan discloses "[T]he telematics unit…transmits via the wireless communicator 130 the preset ID of the activated/selected audio channel preset button 112 to the server. Therefore, the Examiner's rejection of claim 3 is respectfully traversed.

Tan does not disclose, contrary to the Examiner's allegations, "determining if a personal calling number is available" as claimed in claims 6 and 10. At most, Tan discloses preset ID's that identify a preset button, and not a personal calling number. Therefore, the Examiner's rejection of claims 6 and 10 is respectfully traversed.

Furthermore, claims 2-3 and 5-8 depend from claim 1. Claims 2-3 and 5-8 are allowable for at least the same reasons as those for claim 1.

Claims 10-11 and 13-16 depend from claim 9. Claims 10-11 and 13-16 are allowable for at least the same reasons as those for claim 9.

Claims 18-20 depend from claim 17 and are therefore allowable for at least the same reasons as claim 17.

Applicants request withdrawal of the rejection of claims 1-3, 5-11 and 13-20 under 35 U.S.C §102(e).

**B.   Claims 4 and 12 were rejected under 35 USC § 103(a) as unpatentable
over Tan et al. in view of U.S. Patent Application No. US
2003/0190030, to Alton.**

The Applicants have thoroughly considered Examiner Deane's remarks
considering the patentability of claims 4 and 12 over Tan et al. in view of U.S. Patent
Application No. 2003/0188303 A1 to Alton (Alton). The Applicants have also
thoroughly read Alton. The Examiner's rejection is traversed.

There can be no motivation to combine a method and apparatus for controlling a
telematics system and a telecommunications modem deactivation control method and
apparatus. The rationale to modify or combine the prior art may be expressly or
impliedly contained in the prior art *or* it may be reasoned from knowledge generally
available to one of ordinary skill in the art, established scientific principles, or legal
precedent established by prior case law. MPEP §2144, *In re Fine*, 837 F.2d 1071, 5
USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.
1992). *See also In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir.
2000) (setting forth test for implicit teachings); *In re Eli Lilly & Co.*, 902 F.2d 943, 14
USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); *In re Nilssen*,
851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (references do not have to
explicitly suggest combining teachings); *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App.
& Inter. 1985) (examiner must present convincing line of reasoning supporting rejection);
and *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on
logic and sound scientific reasoning).

The Examiner properly does not cite to any express or implied teachings in either
Tan or Alton, as neither reference, alone or in combination, provides any such teaching.
Therefore, the Examiner must be attempting to rely on either knowledge generally
available to one of ordinary skill in the art, established scientific principles, or legal
precedent established by prior case law. The Examiner makes no citation to any
established scientific principles, or precedent established by prior case law, and therefore
can only be relying on knowledge generally available to one of ordinary skill in the art.

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However, the Examiner provides no evidence of the ordinary skill in the art. In a case such as this, where the Examiner is improperly attempting to combine a modem deactivation method with a telematics control method, the Examiner's omission of any details regarding the level of skill of one in the art is especially telling. The mere fact that references *can* be combined is not sufficient to establish obviousness under 35 U.S.C. §103(a). *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990), MPEP §2143.01.

Furthermore, Tan teaches away from the combination with Alton. Tan teaches a method for a user to select data content from a server through a telematics unit by supplying input that is directly associated with the particular data content of interest. The Examiner states that to "incorporate a predetermined timing means as taught by Alton into the Tan et al. device in order to free a user from having to remember to trigger the request manually." In Tan "*a user to activates* a telematics mode on the vehicle thereby initiating a wireless connection from the vehicle to the server. See, ¶20 of Tan (emphasis added). Additionally, in Tan "when *a user presses* a button the telematics unit proceeds..." See, ¶21 of Tan(emphasis added). In contrast, In Alton "the TCU will set a call timer to the allowed execution time. When the allowed execution time has elapsed, the connection will be dropped." See, ¶48 of Alton. There is no suggestion in Tan that a user could or would have a need to place a request for data content other than by a manually initiating the request. The combination with Alton, where a execution timer is set based on an allowed execution time would act only to limit the amount of time a user had to complete the data content selection.

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The Examiner alleges that "it would have been obvious to one of ordinary skill in the art to have used a timer to connect a call at a predetermined time in light of Alton." There is no suggestion in Alton that a timer be used to trigger a call at a predetermined time. Alton expressly states that the timer is needed for "controlling the deactivation of a telecommunications modem, independent of the connection quality, to minimize power consumption" and not as a call initiation trigger. See, ¶17 of Alton.

Finally, claims 4 and 12 depend from independent claims 1 or 9 respectively and contain all of the elements of the respective independent claim. Therefore, claims 4 and 12 are allowable at least for the reasons as those for claims 1 or 9. Applicants respectfully submit that the rejection of claims 4 and 12 under 35 U.S.C. § 103(a) be withdrawn.

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SUMMARY

Examiner Deane's rejection of claims 1-20 is respectfully traversed based on the above discussion. The Applicants respectfully submit that claims 1-23 fully satisfy the requirements of 35 U.S.C. §§ 102 and 103. In view of the foregoing remarks, favorable consideration and early passage to allowance of the present application is respectfully requested.

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Respectfully submitted,
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